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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,221	08/27/2003	Kenichiro Uotani	03500.017508.	4314
5514 7590 12/13/2007 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER QIN, YIXING	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 12/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/648,221

Applicant(s)

UOTANI, KENICHIRO

Examiner

Yixing Qin

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/1/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 10/01/2007 have been fully considered. The argument is that the Onodera reference does not teach any part of the image to be printed on the recording medium to show any parts that would overflow the medium as claimed in the amended claims. The Examiner has found a new reference, McFarland (U.S. Patent No. 6,903,760) that shows image areas that would overflow the printable area of a face or side of a CD or DVD, as seen in, for example, Fig. 4 of McFarland.

This action is made final due to the amendments necessitating a new grounds of rejection. Please see the action below for more details.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-10, and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over McFarland (U.S. Patent No. 6,903,760).

Regarding claims 1, 7, 13, McFarland discloses an image processing method which is used to confirm a layout when an image is formed onto a first recording medium on the basis of an application, the first recording medium being of a disk shape and set in a dedicated tray of a printer, said method comprising:

an image forming step of forming the image based on said application; (Fig. 4)
and

a display control step of controlling a process for displaying the image so that a portion corresponding to an inside of the first recording medium of the image formed in said image forming step and a portion corresponding to an area which would overflow the first recording medium can be discriminated. (One can see in Fig. 4 that there are certain areas that would be outside the label area corresponding to the area of the CD. Item 310 is the label for the CD, whereas areas outside 310 is overflowing the area of the CD as defined by groove 320)

The Examiner is making a 103 rejection because of the shape of the medium.

The McFarland reference does not explicitly disclose that the first recording medium is of a disk shape.

The first recording medium, identified as a label in Fig. 3 of McFarland is arguably being of a disk shape, or at least contains a disk shape. One can reasonably interpret the area 220 to be a first recording medium.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a disk shaped medium.

The motivation would have been to be able to visually compare how an image would be printed on a CD.

Therefore, it would have been obvious to use McFarland or to slightly alter it to obtain the invention as specified.

Regarding claims 2, 8, McFarland discloses further comprising a discriminating step of discriminating, by a discriminating unit, whether a first mode of forming the image onto the first recording medium has been set or a second mode of forming the image onto a second recording medium having a shape mismatched with the dedicated layout has been set, (Fig. 3 and Fig. 6 discloses two shapes that the image can be printed on. The difference in shapes is a mismatch)

wherein if it is determined in said discriminating step that the first mode has been set, said display control step is executed. (Fig. 7, item 600. The act of displaying can be printing the desired image on a medium or showing it in various layouts)

Regarding claims 3, 9, McFarland discloses A comprising a recognizing step of recognizing a size of the first recording medium as a type of the first recording medium in accordance with contents of an instruction from a user, (Fig. 7, item 600, 605 – the user is able to select from a default medium, with set size or from another storage media size)

wherein said display control step is controlled in accordance with the type of the first recording medium recognized in said recognizing step. (again, the layout or print shown would be, for example, in Fig. 4 or Fig. 6 depending on the type of medium to label)

Regarding claims 4, 10, McFarland discloses further comprising a recognizing step of automatically recognizing a type of the first recording medium, (Fig. 7, item 600 selected a default medium, which indicates the system automatically knows its parameters, such as size)

wherein said display control step is controlled in accordance with the type of the first recording medium recognized in said recognizing step. (Fig. 7, would show a layout that corresponds to the default medium, which is a 12cm optical disc – column 6, lines 51-61)

Claims 5, 6, 11 and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over McFarland (U.S. Patent No. 6,903,760) in view of Onodera (U.S. PG Pub. No. 2001/0026531)

Regarding claims 5, 11 the McFarland reference discloses various layouts for CD labeling

It does not explicitly disclose a selecting step of selecting, by a selecting unit, whether said display control step is executed or not,

wherein if it is determined in said discriminating step that said second mode has been set and if it is selected in said selecting step that said display control step is executed, said display control step is executed."

However, Onodera shows in Fig. 13 shows that the display preview is selected and a print preview is shown to the user. Combined with the fact that the McFarland reference shows two different types of recording mediums, it would be obvious to have showed a preview for the second type.

McFarland and Onodera are combinable because both are in the art of printing labels for CDs.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included a setup of whether to preview.

The motivation would have been to allow users to preview images so that they can be sure that a label would be printed correctly.

Therefore, it would have been obvious to combine McFarland and Onodera to obtain the invention as specified.

Regarding claims 6, 12, the secondary reference, Onodera discloses wherein said image processing method is a method which is used to display a print preview of print data formed by an arbitrary application before the print data is print-processed, an

in said display control step, in the case of print-outputting the print data onto the first recording medium in a disk shape including a CD or a DVD, a process for displaying the image so that a difference between a portion which is printed onto the first recording medium and a portion which would overflow the first recording medium can be visually discriminated. (the McFarland reference shows various labels that are printed. It just does not go into much details regarding a print preview. However, Onodera shows a method for print previewing a printed image. Since print preview have long been known, it would have been obvious to have incorporated a print preview with the McFarland reference.)

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

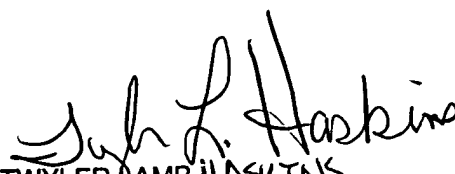
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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